

AMENDMENTS TO THE DRAWINGS

The attached sheets of drawings include changes to Figs. 1, 2, 8, 9a, 9b, 10-16, 17a and 17b. These sheets, which include Figs. 1, 2, 8, 9a, 9b, 10-16, 17a and 17b, replaces the original sheets including Figs. 1, 2, 8, 9a, 9b, 10-16, 17a and 17b, respectively. In these replacements, Figs. 1, 2, 8, 9a, 9b, 10-16, 17a and 17b have been re-traced with removing unclear shading, as requested in the Office action. Additionally, a reference numeral 120' is added in Fig. 11. No new matter is added.

Attachment: Nine Replacement Sheets, and
Nine Annotated Sheets Showing Changes.

REMARKS/ARGUMENTS

Claims 1-46 were pending in the present application before the amendment as set forth above. By this Amendment, claims 1-24 are withdrawn as directed to non-elected subject matter, and claim 25 is amended.

In the August 25, 2009 Office Action, claims 25-31, 33-35, 37-39 and 41-45 were rejected under 35 U.S.C. 102(e) as being anticipated by Balbierz et al. (US2002/0026188, hereinafter "Balbierz"). Claims 32 and 46 were rejected under 35 U.S.C. 103(a) as being unpatentable over Balbierz and in further view of Adair (US4782819, hereinafter "Adair"). Claims 36 and 40 were rejected under 35 U.S.C. 103(a) as being unpatentable over Balbierz and in combination with Hayes et al. (US4967745, hereinafter "Hayes"). Further, the drawings were objected to because Figs. 1, 2, 8, 9a, 9b, 10-14, 16, 17a and 17b, did not have indicia indicative of the function of many of the elements of the drawings.

Additionally, the Office Action also contained restriction requirements under 35 U.S.C. 121 and 372. Specifically, the Examiner indicated that the present application contained two inventions of Group I, claims 1-24, drawn to methods of identifying tissue, and Group II, claims 25-46, drawn to a medical tissue ablation system. Although applicant provisionally elected without traverse the claims of Group II, claims 25-46 for prosecution, during a telephone conversation with the Examiner on June 25, 2009, the affirmation of this election must be made in responding to the Office Action.

Applicants appreciate the Examiner's careful review of the application.

In response, as set forth above, claims 1-24 have been withdrawn as directed to non-elected subject matter. Further, claim 25 has been amended for better form.

Additionally, the drawings have been amended for better form, as suggested by the Examiner. Specifically, Figs. 1, 2, 8, 9a, 9b, 10-16, 17a and 17b have been re-traced with removing unclear shading, as requested in the Office action.

Support for the amendment can be found, for example, in Figs. 1, 3-7, 8, 10, 11, 16 and 18-24 of the drawings, and paragraph [0067] of the specification, as originally filed. Applicant asserts that no new matter is added.

Any amendments to the claims not specifically referred to herein as being included for the purpose of distinguishing the claims from cited references are included for the purpose of

clarification, consistence and/or grammatical correction only.

It is now believed that the application is in condition for allowance at least for the reasons set forth below and such allowance is respectfully requested.

The following remarks herein are considered to be responsive thereto.

Restriction Requirements:

Applicant hereby affirms the election without traverse of the claims of Group II, claims 25-46 for prosecution of the present invention, and that claims 1-24 were withdrawn from further consideration, which were made during the telephone conversation with the Examiner on June 25, 2009.

Objection to the Drawings:

In response, as set forth above, the drawings have been amended for better form, as suggested by the Examiner. Specifically, Figs. 1, 2, 8, 9a, 9b, 10-16, 17a and 17b have been re-traced with removing unclear shading, as requested in the Office action. Accordingly, applicant respectfully submits the drawing objections have been overcome.

35 U.S.C. 102 Rejections:

In response, as set forth above, claim 25 has been amended to recite a medical tissue ablation system including

“a tubular member configured for introduction into a patient and having one or more ablation electrodes extending therethrough and individually deployable from a distal open end of the tubular member into an ablation site within the patient, each of the ablation electrodes being coupled with an ablation energy source, characterized by:

a spectrometer;

at least a first optical fiber encased in a first tubular needle extended through the tubular member with the one or more ablation electrodes and individually extendable from the distal open end of the tubular member into the patient at least proximal to the ablation site, the first optical fiber having a first, distal end exposed to light through a first distal open end of the first tubular needle and a second, proximal end optically coupled with the

spectrometer so as to deliver light collected through the first end of the first optical fiber to the spectrometer for acquiring optical spectra therefrom, wherein the acquired optical spectra includes at least one of *autofluorescence spectra* and *diffuse reflectance spectra*, and wherein *the first tubular needle* comprises a plurality of *scale markers for determining the position* of the first end of the first optical fiber; and

a computer coupled to the spectrometer for analyzing the acquired optical spectra so as to determine tissue characteristics at the corresponding position." (Emphasis added.)

As stated in MPEP §2131, a claim is anticipated under 35 U.S.C. §102 *only if each and every element as set forth in the claim, in as complete details is found in a single prior art reference.* As set forth above, amended claim 25 recites *the first tubular needle* comprising a plurality of *scale markers for determining the position* of the first end of the first optical fiber, and a *computer coupled to the spectrometer for analyzing the acquired optical spectra so as to determine tissue characteristics* at the corresponding position.

Instead, as shown in Figs. 1, 2, 4, 7, 8, 20 and 23 of Balbierz, indicated in the Office action on page 7, and understood by applicant, Balbierz teaches a tissue diagnostic system (paragraph [0002]) having a tubular introducer (12) with one or more resilient members or electrodes (18a-18e) extending through the introducer (12) that are individually deployable and coupled to an ablative source (20, paragraphs [0047] and [0088] and Figs. 1, 2, 7, 20 and 23). Balbierz also teaches a first optical fiber (22md, paragraph [0058]) encased in a non-energy delivery resilient member (18, paragraph [0055] and Fig. 8) extending through the introducer (12) that can deliver light to a spectrometer, which produces spectral signals (19) at its proximal end and collect light from tissue at its distal end (paragraphs [0057]-[0061 and Fig. 4].) However, Balbierz is silent on the limitations of *the first tubular needle* comprising a plurality of *scale markers for determining the position* of the first end of the first optical fiber, and a *computer coupled to the spectrometer for analyzing the acquired optical spectra so as to determine tissue characteristics* at the corresponding position, recited in amended claim 25 of the present invention.

Therefore, for at least the foregoing reasons, Balbierz cannot anticipate the invention as claimed in amended claim 25. Accordingly, amended claim 25 is patentable under 35 U.S.C. § 102 over Balbierz. Claims 26-31, 33-35, 37-39 and 41-45, which depend from now allowable

amended claim 25, are also patentable at least for this reason.

35 U.S.C. 103 Rejections:

Claims 32, 36, 40 and 46 depend from now allowable independent claim 25 and thus are also allowable at least for this reason.

CONCLUSION

Applicants respectfully submit that the foregoing Amendment and Response place this application in condition for allowance. If the Examiner believes that there are any issues that can be resolved by a telephone conference, or that there are any informalities that can be corrected by an Examiner's amendment, please call the undersigned at 404.495.3678.

Respectfully submitted,

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